

II. Claims

Claims 15-28 are now pending. Claims 15-28 stand rejected under the first paragraph of 35 U.S.C. § 112 as lacking enablement. Claims 15, 16, 18, 22, 26-28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,736,935 (“Lambropoulos”). Claims 17, 19-21, 23-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lambropoulos in view of U.S. Patent No. 5,751,073 (“Ross”) and U.S. Patent No. 5,514,914 (“Sellem et al.”).

A. § 112 Rejections

Claims 15-28 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking enablement. In support of the rejection, the Examiner makes the following assertions: a) “the specification merely describes in general terms the desired functionalities of the system without providing specific enablement for the claimed subject matter”; and b) “mere duplication of claimed subject matter in the specification is not enabling what is claimed, merely providing literal antecedent basis.” Applicants respectfully submit that the Examiner has not provided a proper analysis or support for the non-enablement conclusion, as explained in further detail below.

It is respectfully submitted that the standard for determining whether a patent application complies with the enablement requirement is that the specification describe how to make and use the invention -- which is defined by the claims. (See M.P.E.P. § 2164). The Supreme Court established the appropriate standard as being whether any experimentation for practicing the invention was undue or unreasonable. (See M.P.E.P. § 2164.01 (citing Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916); In re Wands, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988))). Thus, the enablement test is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” (See id. (citing United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

As stated before, the Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement, and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See id. (citing In re Wands, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404

and 1407)). In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the examiner’s analysis must therefore “consider all the evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” (See M.P.E.P. § 2164.01). It is respectfully submitted that the Office Action has not addressed these factors.

Importantly, an examiner bears the initial burden of establishing why the “scope of protection provided by a claim is not adequately enabled by the disclosure.” (See id. (citing In re Wright, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993))). Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. (See id.).

It is believed that the present assertions of the Office Action do not meaningfully address -- as they must under the law -- whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation -- which it plainly does. In short, it is believed that the Office Action’s arguments and assertions do not really address the issue of whether one having ordinary skill would have to *unduly experiment* to practice the claimed subject matter of the rejected claims -- a proposition for which the Office bears the burden of proving a prima facie case as to the rejected claims.

In this regard, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of Ex Parte Reese, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner’s subjective belief that the specification was not enabling as to the claims. In particular, the subjective assertions of the Office Action are simply not supported by any real “evidence or sound scientific reasoning” -- which the law requires and which makes plain that the Office (and not the applicant) bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in Ex parte Reese was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without

exercising undue experimentation -- which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. (See id.). Moreover, the Board made clear that it is “incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence,” and also made clear that “[where an] examiner’s [argument] is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph.” (See id. at 1222 & 1223; italics in original).

In the present case, it is respectfully submitted that the Office Action has not satisfied the criteria for establishing lack of enablement. For the foregoing reasons, it is respectfully submitted that the enablement rejection of claims 15-28 should be withdrawn.

B. Claims 15, 16, 18, 22, and 26-28 are not Anticipated by Lambropoulos

Claims 15, 16, 18, 22, and 26-28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Lambropoulos.

To anticipate a claim under § 102, a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, arranged as in the claim. Lindeman, 703 F.2d 1458 (Emphasis added).

Claim 15 recites that “after vehicle entry has been approved, preliminary startup procedures are automatically initiated.” While Lambropoulos teaches that “the microcomputer 80 in transceiver C enables the ignition start circuit 115 permitting starting of the vehicle's engine,” (col. 8, lines 9-11), it may not be deduced from the Lambropoulos reference that “after vehicle entry has been approved, preliminary startup procedures are automatically initiated.” Lambropoulos does not teach a system with the capability to **automatically initiate** preliminary startup procedures; instead, Lambropoulos only teaches enablement of the ignition start circuit 115 to permit engine start **after an intent to start the engine has been signaled by both the ignition start request and depression of the brake pedal**. Hence, claim 15 is not anticipated by Lambropoulos. Claims 16, 18, 22, and 26-28 depend from claim 15, so the above argument regarding claim 15 applies equally to claims 16, 18, 22, and 26-28, and Lambropoulos also fails to anticipate claims 16, 18, 22, and 26-28.

Withdrawal of this rejection is respectfully requested.

C. The Rejection of Claims 17, 19-21, and 23-25 Under 35 U.S.C. § 103(a) Should Be Withdrawn

Claims 17, 19-21, and 23-25 stands rejected under 35 U.S.C. § 103(a). It is contended that these claims are unpatentable over Lambropoulos in view of Ross and Sellem et al. Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, but the prior art must also suggest combining the elements in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See M.P.E.P. § 2142. To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. See M.P.E.P. § 2143. Applicants respectfully submit that these criteria for obviousness are not met here.

Claims 17, 19-21, and 23-25 ultimately depend on claim 15. Consequently, all claim limitations of claim 15 of the present Application that Lambropoulos, Ross and Sellem et al. do not teach or suggest are also not taught or suggested with respect to claims 17, 19-21, and 23-25 of the present Application. As noted above in connection with claim 15, Lambropoulos reference does not teach or suggest a system with the capability to automatically initiate preliminary startup procedures after vehicle entry has been approved. Similarly, Ross and Sellem et al. references also fail to teach or suggest this limitation. Accordingly, claims 17, 19-21, and 23-25 are not rendered obvious for at least the reasons given for allowability of claim 15.

For the foregoing reasons, withdrawal of the rejection under 35 U.S.C. § 103(a) with respect to claims 17, 19-21, and 23-25 is hereby respectfully requested.